

REMARKS

Applicants have carefully reviewed the Decision on Appeal from the Board of Patent Appeals and Interferences dated September 24, 2008, and respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Claim 1 has been amended to require polyurethane (A) to be isocyanate group-free and formed by reacting the isocyanate groups of the polyisocyanates exclusively with the isocyanate-reactive groups of the isocyanate-reactive component. Support for this amendment is implicitly found throughout the Specification, including the Examples, in which only components (A2)-(A5) are used to react with the polyisocyanate. Further, support for the polyurethane (A) being isocyanate group-free is found in the Specification, page 14, lines 11-20.

New Claims 13 and 14 have been added. Support for the claims is found in the Specification, page 14, lines 8-20.

Claims 1, 3-5 and 12 have been rejected under 35 USC 102(b) as being anticipated by WO 2001/77200 to Kagerer et al, which is believed to correspond to U.S. Patent Application 2003/0124357. The Board held that compounds containing thiol groups were not excluded by the appealed claims because the additional step of adding a thiol reactant to an intermediate polyurethane, formed by reacting the polyisocyanates with polyols not containing any thiol groups, was not excluded by the appealed claims.

Applicants traverse this in view of the amendments to Claim 1 and submit that the addition of "exclusively" to Claim 1 makes clear that the NCO groups of the polyisocyanate can only be reacted with the isocyanate reactive groups of compounds from (A2)-(A5). Therefore, even if polyurethanes (A) are prepared by adding the isocyanate-reactive components sequentially as previously suggested by the Examiner, the subsequently added isocyanate-reactive components are still reacting with the isocyanate groups of polyisocyanates (A1) and, thus, the isocyanate-reactive components must still consist of components (A2) to (A5).


The intermediate polyurethane referred to by the Examiner must contain isocyanate groups if it is reactive with isocyanate-reactive groups, such as thiol groups. The only isocyanate groups present in the intermediate polyurethane are

the isocyanate groups present in polyisocyanates (A1). Whenever these groups are reacted, whether in the first stage or in a subsequent stage, the amended claims require these isocyanate groups to react with the isocyanate-reactive groups present in an isocyanate-reactive component that consists of components (A2) to (A5).

Just because the isocyanate groups are reacted in a subsequent step does not mean that the scope of the isocyanate-reactive component is broadened to include thiol reactants. The process of adding the isocyanate-reactive component in two or more steps is disclosed in the specification at page 14, lines 12-20, which discloses preparing a polyurethane prepolymer containing isocyanate groups and subsequently reacting the isocyanate groups with other isocyanate-reactive compounds. Whether the isocyanate-reactive compounds are reacted in one stage or in several stages, the isocyanate-reactive component must consist of components (A2) to (A5), and these components exclude the thiol reactants required by Kagerer et al.

For the preceding reasons it is submitted that Kagerer et al fails to anticipate the subject claims, as amended. Accordingly, withdrawal of this rejection is requested.

Respectfully submitted,

By 
Robert S. Klemz
Attorney for Applicants
Reg. No. 46,305

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3808
FACSIMILE PHONE NUMBER:
(412) 777-3902

Date Of Signature November 21, 2008

LF/KLEMZ/rsk072